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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,459	08/14/2006	Andrew Michael Halliday	1410-67681-US	7180
48940 7590 12/14/2010 FITCH EVEN TABIN & FLANNERY 120 SOUTH LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3406				
EXAMINER				
ATKISSON, JIANYING CUI				
ART UNIT		PAPER NUMBER		
3742				
MAIL DATE		DELIVERY MODE		
12/14/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/589,459

**Applicant(s)**

HALLIDAY ET AL.

**Examiner**

JIANYING ATKISSON

**Art Unit**

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 and 52-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-35 and 52-67 is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The response filed on 11/16/10 is acknowledged. Claims 1-35, 52-67 are now pending, claims 36-51 are canceled, claims 52-67 are new.

Applicant is required to maintain a line of demarcation between the claimed subject matters of applications **11/589,458**, **11/589,459**, and U. S. Patent No. **7673558**.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 52-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "generally" in the phrase of "a generally planar surface" in claim 52 is a relative term or term of degree which renders the claim indefinite. The term "generally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 53-67 are rejected since they are dependent on claim 52.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. (US 6,634,281), hereafter Burrows, and in view of Cai (US 7,032,503).

Regarding claims 1, 12-13, Burrows teaches an insert (12) for use in a beverage preparation machine (10) of a type comprising a brew head (28) suitable for receiving a rigid or semi-rigid cartridge (cavity 32 can receive cartridge), the brew head comprising an upwardly directed inlet (62) for supplying water to the brew head, a downwardly directed outlet (79) for outflow of beverage produced by the machine, the insert comprising an upper part (cap 77), a lower part (12), the upper and lower parts being moveable between an open configuration in which a quantity of beverage ingredients may be loaded into the insert and a closed configuration in which the upper and lower parts are closed to define therebetween a brewing volume containing, in use, the quantity of beverage ingredients, the lower part comprising an inlet (64) and an outlet (holes on mash 78) arranged to communicate respectively with the upwardly directed inlet (62) and the downwardly directed outlet (79) of the brew head of the beverage

preparation machine when the insert is inserted into the machine such that, in use, water from the inlet of the brew head passes upwardly through the inlet of the insert into the brewing volume and such that beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert to flow out of the downwardly directed outlet of the brew head (col. 5, lines 49-54, col. 6, lines 58-62).

Burrows does not teach explicitly a sealing means to seal the upper and lower parts when they are closed to form the brewing chamber; or the sealing means comprises a ring seal or an O-ring for sealing around a periphery of the brewing volume.

In the same field of endeavor of beverage brewing machine, Cai teaches a sealing means (a ring seal 25 or O-ring 16) used to form airtight seal for a brewing chamber (col. 3, lines 12-14).

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use **in Burrows** the ring seal or O-ring **as taught by Cai** between the basket 12 and the cap 77 **in order to** form airtight connection there-between thus to ensure no hot steam escapes outside to burn the user.

Regarding claim 2, Burrows teaches that the insert as claimed in claim 1 wherein the quantity of beverage ingredients (ground coffee) loaded in use into the receptacle are loose (ground coffee is loose).

Regarding claim 3, Burrows teaches that the insert as claimed in claim 2 wherein the insert comprises filtering means (78) between the brewing volume and the outlet of the insert.

Regarding claim 4-9, Burrows teaches the limitations of claim 1, but does not teach explicitly that the insert as claimed in claim 1 wherein the quantity of beverage ingredients loaded in use into the receptacle are contained in a container comprising filtering means (*Regarding claim 4*); or that the insert as claimed in claim 4 wherein the container is flexible (*Regarding claim 5*); or the container is formed at least in part from a filtering membrane (*Regarding claim 6*); or the container is a filter bag (*Regarding claim 7*); or the container is a rigid or semi-rigid cartridge (*Regarding claims 8-9*).

However since Burrow teaches a beverage machine with brewing head and brewing basket, thus it would have been obvious to a person of ordinary skill in the art at the time of invention to insert a rigid or semi-rigid cartridge or any other type of filter (filter bag, flexible filter, filtering membrane, etc) of any of semi-spherical, cylindrical, round or square in shape in the brewing basket to make beverages, since prepacked cartridges can contain a pre-determined dose of coffee and different filter means are suitable for making different kinds of coffee.

Regarding claims 10-11, Burrows in view of Cai teaches that the insert as claimed in claim 9, wherein the sealing means (16) is located on or in an upper part or the lower part of the insert (Figs. 1-2 of Cai).

Regarding claim 14, it is well known that O-rings are commonly made from an elastomeric material.

Regarding claim 15, Burrows in view of Cai teaches that the insert as claimed in claim 14, wherein the upper part and the lower part are disconnected from one another (Fig. 6 of Burrows).

Regarding claims 16 and 17, Burrows teaches the limitations of claim 15, but does not teach that the upper part and lower part comprise co-operating formations to permit snap-fitting together of the upper part and lower part; or the upper part and lower part are joined by a hinge allowing the upper and lower parts to move between the open and closed configurations.

However it is well known that snap-fitting is a commonly used means to fit a cap to a receptacle to form a closed chamber, and a hinge is commonly used to open and close a lid; thus it would have been obvious to a person of ordinary skill in the art at the time of invention to include co-operating formations or hinge means to permit snap-fitting together of the cap 77 and the receptacle 12 to form an enclosed brewing chamber, or close and open the cap through the hinge means.

Regarding claims 18-19, Burrows teaches the limitations of claim 17, Burrows also teaches a closure mechanism of the beverage preparation machine (lid 38) that the insert is rigid or semi-rigid, and sufficient force is applied to a cap 77 to close the basket to prevent undesired spilling (col. 6, lines 25-28) (*Regarding claim 18*); and the lower surface of the insert seals against the inlet of the brew head of the beverage preparation machine (col. 5, lines 38-41) (*Regarding claim 19*). Burrow does not teach that said closure mechanism (38) squeezes the insert.

However it would have been obvious to a person of ordinary skill in the art at the time of invention to extend the lid 38 to cover the whole top section of brew head 28 to prevent dust from getting in the cavity 32 and to improve the hygiene. Thus when pressure is applied to the extended lid to close the lid portion, cap 12 of the insert will be

squeezed to seal against the receptacle of 12, and the lower surface of the insert 12 will seal against the inlet of brew head for hot water communication.

Regarding claim 20, Burrows in view of Cai does not teach that the upper part is in the form of a domed shell, however a doomed shell or other shape would be a design choice.

Regarding claim 21, Burrows teaches that the lower part of the insert is formed as one piece (brewing basket 12 is one piece in use).

Regarding claim 22, Burrows teaches that the lower part of the insert is formed from more than one piece (basket 12 is formed from more than one piece, 72, 82, 78, etc).

Regarding claim 23, Burrows teaches that the insert is disc-shaped (the upper cap 77 is disc-shaped).

Regarding claim 24, Burrows teaches that the insert is formed from plastic (col. 5, line 46).

***Allowable Subject Matter***

4. Claims 25-35, 52-67 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter: allowance of claims 25-35, 52-67 is indicated because none of the prior art of record, alone or in combination, appears to teach, or fairly suggest or render obvious an insert to use in a brew head wherein the insert having an inlet and an outlet in the lower portion of the insert and **the inlet and the outlet are coplanar**, as recited in claims 25, 52.

**Response to Arguments**

Applicant's arguments have been fully considered but they are not persuasive.

Regarding claim 1, applicants argue that *"the applied references fail to disclose or suggest an insert for use in a beverage preparation machine of a type comprising a brew head "such that, in use, water from the inlet of the brew head passes **upwardly through the inlet of the insert into the brewing volume** and such that beverage produced from the water and the quantity of beverage ingredients **passes downwardly through the outlet of the insert**" as recited in claim 1"*.

Applicants admit that *"The Office Action **correctly** asserts that **water is communicated upwardly into plenum chamber 70 through a feed port 64**. However, the plenum chamber 70 is not the brewing volume containing the beverage ingredients, as claimed. Rather, the plenum chamber 70 is upstream of the interior of the brew basket containing ground coffee and is for distributing water to at least one of the hollow ribs 72 formed in the side wall of Burrows' brew basket 12. (Burrows, Col. 5, lines 49-54)."*

Since the applicants admit that water is passed upwardly through the inlet (64), thus the claimed limitation is met. In addition to the teaching of upward flow of the water, Burrows further teaches the water path through the jets 14. Thus Burrows teaches more than the claimed limitation.

Applicants further argue that *"the Office Action's allegation that the brewed beverage of Burrows passes downwardly through the filter elements 78 is incorrect. The*

*filter elements 78 are provided in the side wall 68 of the brew basket 12, such that the flow is radially outward from the brew basket. This is described in Burrows as follows:*

*This spinning fluidized bed is directed by centrifugal action in a generally radially outward direction against an inboard side wall of the brew basket, a portion of which is defined by the mesh filter element or elements which permit outward flow-through passage of the brewed liquid coffee while substantially preventing outward passage of the coffee grounds. (Burrows, Col. 2, lines 46-53). It is clear from the description of Burrows that fluid flow is radially outward through the filter 78 and not downwardly as the Office Action alleges*

**The examiner respectfully disagrees. Say when the machine of Burrows is turned off, i.e., no centrifugal action or force exist on the fluidized bed, the beverage made/remained in the brewing chamber will flow out downwardly by gravity.**

Regarding claims 4-9, applicant argue that to use a container with a filter in the brew basket 12 would interrupt the function of the brew basket and modify the brew basket 12 unsatisfactory for its intended purpose.

The examiner respectfully disagrees. As evidenced by Cai (US 6,777,007) and Dinos (US 4,983,410), pods or cartridges are known to be used in brewing head for making beverages; and such pods or cartridges have water permeable walls so that the jet of Burrows can pass through the walls and agitate and stir the ingredient contained in the pot or cartridges for making beverages. Further since there is no modification of the structures of Burrows by using a bag or container to contain the beverage ingredients, thus the function of the brew basket wouldn't be modified.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JIANYING ATKISSON whose telephone number is (571)270-7740. The examiner can normally be reached on Mon-Friday. 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on (571)-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JIANYING ATKISSON/  
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12/10/10

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